

PATENT
P55971

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES**

In re Application of:

Appeal No. _____

KI-SEON KIM *et al.*

Serial No.: 09/503,240

Examiner: FISHER, MICHAEL

Filed: 14 February 2000

Art Unit: 3629

For: **MONITOR CASE COMPRISING FACILE DETACH STRUCTURE**

Attn: Board of Patent Appeals and Interferences

REPLY BRIEF

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Sir:

Pursuant to 37 C.F.R. §1.193(a) and (b), Appellant hereby requests entry of this Reply Brief in response to the Examiner's Answer mailed on 10 August 2004.

This Reply Brief is filed in triplicate (37 C.F.R. §1.192(a)), together with a written Request for An Oral Hearing before the Board of Patent Appeals and Interferences.

Folio: P55971
Date: 10/12/04
I.D.: REB/SS/sb

REMARKS

In response to the August 10, 2004 Examiner's Answer, the following remarks are submitted:

Claims 1, 13, 16, and 21 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of Kim *et al.* (U.S. Patent No. 6,233,026). Furthermore, claims 1, 13, 16, and 21 have been rejected under 35 U.S.C. § 103 as obvious over Beak (U.S. Patent 5,863,106).

Claims 1-11 of Kim *et al.* include independent claims 1, 4, 6, 8, 9, 10, and 11. Each of these independent claims recites a front case having a cathode ray tube installed at the rear portion thereof and a bottom shield that is secured to the front case.

On the other hand, claim 1 of the present application recites a front casing, a rear casing, and an engaging portion arranged to enclose a cathode ray tube between the front and rear casings. Similarly, claim 13 of the present application recites a front casing, a rear casing, and a detent portion and a guide arranged to enclose a cathode ray tube between the front and rear casings. Claim 16 of the present application is similar to claims 1 and 13 but recites a wall surrounding a first hole engaging with an engaging pin and including a snap pin to attach front and rear casings receiving a cathode ray tube. Claim 21 of the present application is a method claim reciting forming front and rear casings attached together by at least one engaging portion and snap portion

and snap pin.

While claims 1-11 of Kim *et al.* superficially bear similarities to claims 1, 13, 16, and 21 of the present application, the Examiner has incorrectly argued that the recited bottom shield of Kim *et al.* can be ignored in comparing 1, 13, 16, and 21 of the present application and claims 1-11 of Kim *et al.*

The Examiner argued that Kim *et al.* has a lower shield that is not necessary to the workings of the prior art and is well settled in case law. Appellants strongly disagree with the Examiner's arguments in that Kim *et al.* is specifically directed to a monitor comprising a snap engaging bottom shield as noted in the title and abstract of Kim *et al.* The entire thrust of Kim *et al.* is directed to securing the bottom shield to the front case of the monitor arrangements.

Furthermore, Kim *et al.* illustrates but does not even discuss how the rear case 6 thereof is attached to the front case 4 thereof nor do claims 1-11 of Kim *et al.* even recite a rear case.

Moreover, the language of *In re Karlson*, 311 F.2d 581, 584, 136 USPQ 184, 186 (CCPA 1963) used by the Examiner was never intended to short-circuit the clear wording of 35 U.S.C. §103. A finding of obviousness must be based upon a determination of obviousness under section 103 and not upon a mechanical rule extracted from *In re Karlson*. See *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965). It is improper to use *per se* rules to sidestep the fact-

intensive inquiry mandated by section 103. *See In re Ochiai*, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995). *See also Ex parte* Edwin G. Sawdon and Brian D. Petit, decision of the Board of Patent Appeals and Interferences, Patent No. 6,722,842, Paper No. 34, page 7 (Appeal No. 2003-0693).

Accordingly, it is submitted that claims 1, 13, 16, and 21 of the present application recite features, such as the rear case and the elements used to secure the front case to the rear case, that are neither taught nor suggested by Kim *et al.* nor obvious thereover. Furthermore, it is submitted that the bottom shield recited in claims 1-11 of Kim *et al.* and not cited in claims 1, 13, 16, and 21 of the present application cannot be ignored since the bottom shield of Kim *et al.* is in fact the subject matter of the recited invention of Kim *et al.*

Beak is related to an apparatus for affixing a printed circuit board within a monitor case. A front case and a rear case each including coupling arrangements to secure the printed circuit board to the bottom portions thereof.

Beak does not teach or suggest the recited elements of claims 1, 13, 16, and 21 of the present application used to secure the front and rear casings nor would such recited elements be obvious thereover. Furthermore, Beak does not teach or suggest or even consider the recited

elements of claims 1, 13, 16, and 21 of the present application used to secure the front and rear casings being arranged at both upper and lower portions of the front and rear casings nor would the arrangements of such recited elements be obvious thereover.

That is, Beak does not teach or suggest securing the front and rear casings together as recited in claims 1, 13, 16, and 21 of the present application nor does Beak teach or suggest securing the front and rear casings together at both the top and bottom portions thereof as recited in claims 1, 13, 16, and 21 of the present application, nor would such features be obvious thereover.


The Applicant disagrees with the Examiner's argument, regarding the snap portion being at the top of the casing, of shifting of parts being a matter of design choice and that such shifting would not materially affect the operation of the prior art apparatus. First, a "design choice" is a conclusion rather than a reason for rejecting a claim under 35 U.S.C. §103. The Examiner must provide a specific reasoning to support the assertion of design choice. *See In re Chu*, 66 F.3d 292, 36 USPQ 2d 1089 (Fed. Cir. 1995). The mere fact that the prior art could be modified does not make such a modification obvious absent suggestion of the desirability of the modification. *See* MPEP §2143.01; *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Otherwise, the Examiner is simply taking the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999). Here, shifting not materially

affecting the operation of the prior art apparatus is not a specific reason to support the suggestion to modify. Moreover such a statement is not shown to be true especially since Beak concerns the connection of the printed circuit board to the front case.

In view of the above, it is submitted that the Examiner's rejection of claims 1, 13, 16, and 21 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of Kim *et al.* and the Examiner's rejection of claims 1, 13, 16, and 21 under 35 U.S.C. § 103 as obvious over Beak are incorrect and accordingly, it is respectfully requested that the Examiner's rejections be reversed.

A Request for Oral Hearing accompanies this Reply Brief. No fee is enclosed since such fee was paid on January 28, 2004. Should the Request become lost, the Commissioner is kindly requested to treat this paragraph as such a request. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



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